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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,158	04/23/2001	Hirokazu Kawamoto	35.G2785	1598
5514 7590 01/02/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER RUDOLPH, VINCENT M	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/839,158

Applicant(s)

KAWAMOTO ET AL.

Examiner

Vincent M. Rudolph

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43,45,49,51 and 73-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43,45,49,51 and 73-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43, 45, 49, 51 and 73, 75, 77 and 79 are rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 7,253,911. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose outputting data using two different formats of data.

Regarding present claim 43, patented claim 5 discloses setting through the Graphical User Interface a single print job that whenever it executes the selected mode, it produces a first data including presentation material and a second data including distribution material that outputs multiple copies as well as includes specific command

for each data and finally output the data using the print device. The present claim claims a print-out format in a first mode and a plurality of different print-out formats in a second mode. It would have been obvious to have the modes as different data of the patented claims since they both relate to different print-out formats as well as including a command part for describing the group of job commands and the included print data. Even though the patented claim claims this information within a printing device, it would have been obvious to have this information within the information processing apparatus in order for the print device to determine the data being sent. Therefore, each limitation claimed in the present claim 43 is broader than the corresponding limitation in the patented claim 5.

In view of this, it is noted that allowing the present claim 43 would result in an unjustified or improper timewise extension of the "right to exclude" granted by a patent.

Regarding present claim 45 for having one format in which one page is printed out onto one sheet and another format in which a plurality of pages are printed out on one sheet, patented claim 5 claims that the presentation material is printed onto one page, but the distribution material is able to have multiple pages printed onto a single page using the N-in-1 layout.

Regarding present claims 49 and 51, patented claim 1 claims a method for executing the processes claimed in patented claim 5 as disclosed above in claims 43 and 45.

Regarding present claim 73, patented claim 5 claims the same rationale as disclosed within claim 43 above, except instead of a first mode and second mode, the present claim claims the output formats as a first print setting and a second print setting.

Regarding present claim 75, patented claim 5 claims the same rationale as disclosed within claim 43 above, except instead of a first mode and second mode, the present claim claims the output formats as a first format and a second format in a printing operation.

Regarding present claims 77 and 79, patented claim 1 claims a method for executing the processes claimed in claim 5 of the patent as disclosed above in claims 73 and 75.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43, 45, 49, 51 and 73-83 are rejected under 35 U.S.C. 103(a) as being anticipated by Livingston ('632) in view of Hicks ('353).

Regarding claim 43, Livingston ('632) discloses an information processing apparatus (computer, See Figure 1, Element 100) capable of communicating with a printing apparatus (printer, See Figure 1, Element 102) for executing a printing operation (See Col. 3, Line 43-46) and includes a setting means (the computer performs the action, thus is becomes the means) for setting, via a GUI in the information

processing apparatus (an application program, See Col. 3, Line 54-55), a print-out format for single print data in a mode using a plurality of different formats for one piece of data (user is able to select different features for outputting the print data, See Col. 4, Line 65-Col. 5, Line 4), producing means for producing a print job to be printed by the printing apparatus in accordance with the setting means (receives the information from the user in order to produce the print job, See Col. 9, Line 19-21), the print job includes a command part describing a group of job commands (features to the page that is to be printed, See Col. 4, Line 52-57) and a print data part describing print data by a print language (imaging operation done by a printer driver for printing, See Col. 9, Line 24-30), and a sending means for sending the print job produced to the printing apparatus (sends the print job through the print driver to the selected printer, See Col. 9, Line 24-26).

Livingston ('632) does not disclose a print-out format in a first mode and a plurality of different print-out formats in a second mode, such that the group of job commands described in the second mode include a print control command representing the second mode for enabling the printing apparatus to execute a printing operation of a plurality of different print-out formats from the common print data described in the print data.

Hicks ('353) discloses a print-out format in a first mode (transparencies, See Figure 3) and a plurality of different print-out formats in a second mode (supporting sets, which include dividers, master set and hand out set, See Figure 3), such that the group of job commands described in the second mode include a print control command

representing the second mode for enabling the printing apparatus to execute a printing operation of a plurality of different print-out formats from the common print data described in the print data (user selects the supporting sets to be included with the transparencies prior to outputting the data, See Col. 7, Line 23-32).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include different modes and the commands to include within it, such as the one disclosed within Hicks ('353), and incorporate it into the information processing apparatus of Livingston ('632) because it enables a printer to understand the desired settings set by a user on the graphical user interface on the computer in order generate the document and output it accordingly.

Regarding claim 45, Livingston ('632) discloses that the plurality of different print-out formats includes one format where one page is printed out onto one sheet (such as duplex printing) and another format where a plurality of pages are printed out onto one sheet (printing multiple pages per sheet, See Figure 3; Col. 4, Line 58-Col. 5, Line 4).

Regarding claim 73, Livingston ('632) discloses an information processing apparatus (computer, See Figure 1, Element 100) capable of producing a print job to be printed by the printing apparatus (See Col. 3, Line 43-46), the print job including a command part (features to the page that is to be printed, See Col. 4, Line 52-57) and a print data part (imaging operation done by a printer driver for printing, See Col. 9, Line 24-30) and apparatus includes a user interface means (keyboard, See Figure 1, Element 112) for setting a print setting from the information processing apparatus so that the printing apparatus can output the print data included in the print job in an output

format (user enters information to the application program so that it is able to be outputted to the printer, See Col. 3, Line 54-58), a setting means (the computer performs the action, thus it becomes the means) for setting the print control command to specify the output format on the print setting to the command part included in the print job so that the printing apparatus can output the print data included within the print job in the selected output format (user selecting any features to apply to any of the pages of print data, See Col. 4, Line 52-57), producing means for producing the print job including the command part and the print data part (receives the information from the user in order to produce the print job, See Col. 9, Line 19-21), and sending means for sending the print job produced to the printing apparatus (sends the print job through the print driver to the selected printer, See Col. 9, Line 24-26).

Livingston ('632) does not disclose setting a first and a second print setting so that that print data included is in a first output format as well as a second output format and setting the first and second print control command for specifying the output formats based on the print setting respectively so that the printing apparatus can output the print data included in the print job in the first output format and the second output format.

Hicks ('353) discloses a first print-out format in a first print setting (transparencies, See Figure 3) and a second print-out format in a second print setting (supporting sets, which include dividers, master set and hand out set, See Figure 3), and sets the first and second print control command for specifying the output formats based on the print settings (user selects the supporting sets to be included with the transparencies, See Col. 7, Line 23-32 as well as the options for both prior to outputting

the data, See Col. 7, Line 42-67) so that the printing apparatus can output the print data in the first and second output format (print the data according to the selected supporting set and the order to output it, See Figure 4; Col. 8, Line 19-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include different settings for different output formats and the commands to include within it, such as the one disclosed within Hicks ('353), and incorporate it into the information processing apparatus of Livingston ('632) because it enables a printer to understand the desired settings set by a user on the graphical user interface on the computer in order generate the document and output it accordingly.

Regarding claim 74, Livingston ('632) discloses that the first output format and second output format are different N-up layout printings (different N-up layout for the preset class, See Col. 8, Line 21-54).

Regarding claim 75, Livingston ('632) discloses an information processing apparatus capable of communicating with a printing apparatus (See Figure 1) and includes a user interface means (keyboard, See Figure 1, Element 112) for setting a plurality of print settings to enable the printing apparatus to execute a printing operation of print data in an output format (user selects features to apply to any of the pages of print data, See Col. 4, Line 52-57), issuing means for issuing a print instruction for producing a print job to be printed by the printing apparatus (a program module is used in generating a hard copy by communicating with a printer, See Col. 3, Line 43-46), producing means for producing, in accordance with the print instruction issued, one print job including the print data and the plurality of print settings (receives the information

from the user in order to produce the print job, See Col. 9, Line 19-21, including the features selected to be printed onto the print data, See Col. 4, Line 52-57), and sending means for sending the print job produced to the printing apparatus (sends the print job through the print driver to the selected printer, See Col. 9, Line 24-26).

Livingston ('632) does not disclose executing a printing operation in a first and second format such that the printing apparatus prints, according to the print instruction, all of the print data in the first format and the second format.

Hicks ('353) discloses executing a printing operation in a first format (transparencies, See Figure 3) and a second format (supporting sets, which include dividers, master set and hand out set, See Figure 3) such that the printing apparatus print, according to the print instruction (using the selected information, See Col. 7, Line 23-32), all of the print data in the first format and the second format (print the transparency and the supporting set data according to the selected options for each, See Col. 9, Line 59-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include different formats according to the print instruction, such as the one disclosed within Hicks ('353), and incorporate it into the information processing apparatus of Livingston ('632) because it enables a printer to understand the desired settings set by a user on the graphical user interface on the computer in order generate the document and output it accordingly.

Regarding claims 49, 51, and 76-80, the rationale provided in the rejection of claims 43, 45 and 73-75 is incorporated herein. In addition, the apparatus of claims 43,

45 and 73-75 corresponds to the apparatus of claim 76 as well as the method of claims 49, 51 and 77-80 and performs the steps disclosed herein.

Regarding claim 81, Livingston ('632) discloses a computer readable medium storing a control program for implementing the method (See Figure 1, Element 108).

Regarding claims 82-83, the rationale provided in the rejection of claim 81 is incorporated herein. In addition, the method of claim 81 corresponds to the method of claims 82-83 and performs the steps disclosed herein.

Response to Arguments

Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new grounds of rejection. Thus, the prior art of Hicks used in combination with Livingston to meet the limitations of the amended claims as disclosed within the rejection above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

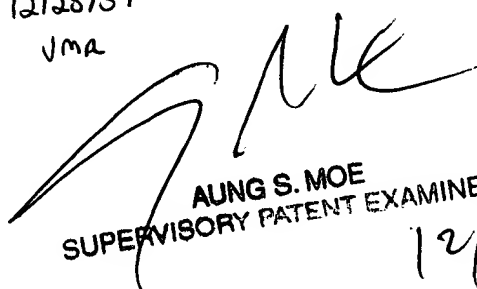
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/20/07
VMA


AUNG S. MOE
SUPERVISORY PATENT EXAMINER

Vincent M. Rudolph
Examiner
Art Unit 2625

12/21/07